

File



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,130	08/29/2001	Robert McClure	DGI-105-A	6581

7590 10/25/2004
Philip R. Warn
WARN, BURGESS & HOFFMANN, P.C.
P.O. BOX 70098
ROCHESTER HILLS, MI 48307

EXAMINER

HUYNH, KIM T

ART UNIT PAPER NUMBER

2112

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,130

Applicant(s)

MCCLURE ET AL.

Examiner

Kim T. Huynh

Art Unit

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-3, 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/29/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ¶
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Specification is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The specification contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examples of some unclear, inexact or verbose terms used in the specification are: no description of figure 21-25, about the LEDs such as the flowchart , controller nor programming. Rule 37CFR 1.74, See MPEP 608.01(g)

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al. (US Patent 6,647,323)

As per claim 2, Robinson discloses a protocol adapter for transferring diagnostic signals between in-vehicle networks and a computer, said adapter comprising:

- Circuitry (fig.1, 12) for transferring the signals between the in-vehicle networks and the computer for a plurality of different protocols, said circuitry including an RS232 bus for transferring the signals for the plurality of protocols; and (col.2, lines 21-35), (col.3, lines 25-44)
- A device for indicating that signals are being transferred between the adapter and the computer on the RS232 bus,(col.3, lines 15-18) said device also indicating which of the plurality of protocols is being used. (col.2, lines 36-55)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (US Patent 6,647,323) in view of Abudayyeh et al. (US Patent 6,081,858)

As per claim 3, Robinson discloses all the limitations as above except wherein the device includes at least one LED to visually indicate activity on the RS232 bus between the adapter and the computer. However, Abudayyeh discloses sensor circuit 206 detects a data transfer activity on bus, it generates a pulse and outputs such pulse in a signal to LED transform circuit. Upon receiving the signal

generated by activity sensor circuit, LED regulates the waveform in accordance to the provide the regulated signal to LED circuit for display. (col.4, line 61-col.5, line 13)

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Abudayyeh's teaching into Robinson's system so as to reduce the flickering rate of the LED circuit so that the effectiveness of the visual effect intended can be maximized. (col.2, lines 4-7)

6. Claim 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (US Patent 6,647,323) in view of Abudayyeh et al. (US Patent 6,081,858) and further in view of Chaloux (US Patent 5,764,156)

As per claim 10, Robinson discloses all the limitations as above except wherein the at least one LED is a plurality of LEDs for indicating which of the plurality of protocols is being used at any given time. However, Chaloux discloses a counter counts the number of cycles in the difference signal during each pulse and outputs a logic signal one of lines S, M and L. The decoder includes logic for energizing the LED when both S and M pulses are detected. The microcontroller provides a communication protocol selector which selects a series of protocols from a protocol memory for controlling the frequency generator and frequency switching control setting the conditions used in the protocol analyzer. The protocol analyzer identifies identification signals to a display. (col.4, lines 26-61)
The protocol analyzer comprises circuitry for detecting response signal levels

and durations and employs criteria for identifying a type of signal. (col.5, lines 14-18)

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Chaloux's teaching into Robinson's system so as to provide an easy-to-use device for detecting and identifying the type of protocols. (col.1, lines 61-63)

As per claim 11, Chaloux does not explicitly disclose wherein the plurality of LEDs is 8 LEDs. However, Chaloux discloses four types of signaling protocols. In addition, Chaloux discloses the device is capable of recognizing new models as they become available, the protocol memory is replaceable by replacing a memory chip. (col.5, lines 34-40). Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to have an additional LEDs (ie 8 LEDs as claimed) in system so as to expand various numbers of protocols in use.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (US Patent 6,647,323) in view of Abudayyeh et al. (US Patent 6,081,858), further in view of Chaloux (US Patent 5,764,156) and further in view of Stroth et al. (Pub No US20020039026)

Robinson discloses all the limitations as above except wherein the plurality of LEDs include at least one dual-color LED. However, Stroth discloses that it was known to use dual color LEDs to indicate different test result in test device. [0094]

It would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate Stroth's teaching into Robison's system in order to display additional information when conducting a test.

Response to Amendment

8. Applicant's amendment filed on 7/29/04 have been fully considered but are moot in view of the new ground(s) of rejection.

a. In response to applicant's argument that Ferran does not teach or suggest a protocol adapter that transfers diagnostic signals between in-vehicle networks and a computer for a plurality of different protocols. However, Robinson discloses vehicle controller provides a dynamic method and apparatus to detect and communicate with multiple tools that are attached and detached to a vehicle communication network. The vehicle controller includes communication specific hardware and software that are able to receive and transmit information over a plurality of standard communication protocols. (col.2, lines 21-36)

Thus, the prior art teaches the invention as claimed and the amended claims do not distinguish over the prior art as applied.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2112

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

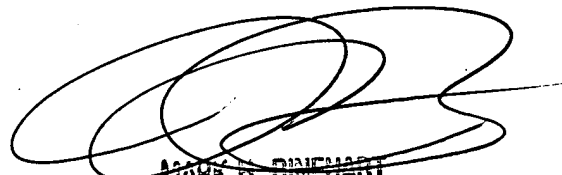
10. *Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (571)272-3635 or via e-mail addressed to [kim.huynh3@uspto.gov]. The examiner can normally be reached on M-F 9:00AM- 6:00PM.*

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (571)272-3632 or via e-mail addressed to [mark.rinehart@uspto.gov]. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

Kim Huynh

October 8, 2004


MARK H. RINEHART
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100